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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,928	01/08/2004	Alice Erwin	PP19720.004	8364

7590 07/13/2006

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Intellectual Property  
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EXAMINER
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DAVIS, BRIAN J

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/754,928

Applicant(s)

ERWIN ET AL.

Examiner

Brian J. Davis

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-28 and 34-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-28, 34-57 and 60 is/are allowed.
- 6) ☒ Claim(s) 58, 59 and 61-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Clarification**

The finality of the previous Office Action is withdrawn. (The Office Action should have been a second non-final action.) The examiner regrets the error.

### ***102 Rejections Withdrawn***

The several rejections of claims 25-49 under 35 USC 102(b), outlined in the previous Office Action, have been overcome by applicant's amendment. With respect to claims 29-33, the amendment cancels the claims. The amendment narrows claim 25 such that it no longer reads on the cited art. With respect to the remaining claims, the rejection is moot.

### ***Double Patenting Rejections Maintained***

The provisional double patenting rejection over 11/289,658 (still in preexam processing) and expanded to include 11/417,346 (also in preexam processing), outlined in the previous Office Action, is maintained for reasons of record. The examiner notes for clarity of the record, however, that when all pending claims in the instant application are allowable except for this provisional double patenting rejection, the rejection over both these applications will be withdrawn in accordance with MPEP 804 (1) (B2).

***Claim Rejections - 35 USC § 102, NEW***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 58 and 59 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by WO 9906340 (CAPLUS abstract of record). The reference teaches applicant's compounds: RN=220390-63-6 and 220390-64-7.

Claims 61-67, in so far as they read on the species below, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by WO 9705105 (CAPLUS abstract of record). The reference teaches applicant's compounds: RN=188030-34-4 and 188030-36-6.

Claims 61-67, in so far as they read on the species below, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by WO 9742179 (CAPLUS abstract or record). The reference teaches applicant's compounds: RN=199484-15-6.

Claims 61-67, in so far as they read on the species below, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by WO 9906340 (CAPLUS abstract of record). The reference teaches applicant's compounds: RN=220390-63-6 and 220390-64-7.

***Allowable Subject Matter***

Claims 25-28, 34-57 and 60 are allowed.

As was stated in the previous Office Action, all species have been searched and all species remain allowable except those used in the formulation of the rejection above.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 **BRIAN DAVIS**  
**PRIMARY EXAMINER**

Brian J. Davis  
June 29, 2006